

REMARKS

The present Amendment and Response is being filed responsive to an Official Action dated June 28, 2004. In this Amendment and Response, the Applicant has canceled claims 16 and 17 without prejudice and added new claims 18-37. Claims 1-8 and 15 have been amended. Although the Applicant does not concede the correctness of the rejections relating to the canceled and amended claims, the amendments to claims 1-8 and 15 are believed to make those claims more clear. Upon entry of the amendments, claims 1-15 and 18-37 will be pending in the present patent application.

In the Office Action, claims 1-17 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctively claim the subject matter which the applicant regards as the invention. Claims 1, 3, 5 and 9 were rejected under 35 U.S.C. § 102(b) as being anticipated by Pease (U.S. Pat. No. 5,647,003). Claims 2 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pease in view of Keronen et al. (U.S. Pat. No. 6,567,530). Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Pease. Claims 6, 7, 10-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pease in view of common practice in the art. Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pease in view of Sedlak et al (WO 99/08230).

With respect to the newly added claims, the Applicant respectfully asserts that no new matter has been added. In addition, the Applicant respectfully asserts that new claims 18-37 are patentable and requests favorable consideration and allowance of those claims.

The Rejections Under 35 U.S.C. § 112, Second Paragraph

In the Office Action, claim 1 and the claims dependent thereon were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctively claim the subject matter which the applicant regards as the invention. The Applicant respectfully traverses these rejections.

In ruling on a claim of patent indefiniteness, a court must determine whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. *Personalized Media Communications, Inc. v. Int'l Trade Comm'n*, 161 F.3d 696, 705, 48 U.S.P.Q.2d 1880 (Fed. Cir. 1998); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986). A claim is not indefinite merely because it poses a difficult issue of claim construction; if the claim is subject to construction, i.e., it is not insolubly ambiguous, it is not invalid for indefiniteness. *Honeywell Int'l, Inc. v. Int'l Trade Comm'n*, 341 F.3d 1332, 1338-39, 68 U.S.P.Q.2d 1023 (Fed. Cir. 2003). That is, if the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons disagree, a claim is sufficiently clear to avoid invalidity on indefiniteness grounds. *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375, 60 U.S.P.Q.2d 1272 (Fed. Cir. 2001). The failure to define a term is not fatal; if the meaning of the term is fairly inferable from the patent, an express definition is not necessary. *Bancorp Services LLC v. Hartford Life Insurance Co.*, 69 U.S.P.Q.2d 1996, 2000 (Fed. Cir. 2004). Even though an entire term is not defined in a patent or industry publications, individual components of the phrase may have well-recognized meanings to those of skill in art and a reader can infer the meaning of the entire phrase with reasonable confidence. *Id.*

Claims 1-8 and 15 are currently amended to set forth the claimed subject matter more clearly. The Applicant respectfully requests the Examiner to not repeat the rejection of claims 1-15 under Section 112.

The Rejections Under 35 U.S.C. §§ 102 and 103

Independent claim 1 and dependent claims 3, 5 and 9 were rejected under 35 U.S.C. § 102(b) as being unpatentable over Pease. The remaining claims were rejected under 35 U.S.C. § 103(a) based on Pease as modified or in combination with other references. The Applicant respectfully traverses these rejections.

With respect to the rejection of claims 1, 3, 5 and 9 under Section 102, anticipation can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). In order to maintain a proper rejection under section 102, a single reference must teach each and every element or step of the rejected claim, else the reference falls under section 103. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicant need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Independent claims 1, 18 and 25 recite “encoding the document key with an element of an image printed on the physical media to produce an encoded document key, *the encoded document key linking the unique physical attribute of the physical media to the image printed on the physical media.*” Emphasis added. New independent claim 32 recites “an encoder adapted to encode the document key with an element of an image printed on the physical media to produce an encoded document key, *the encoded document key linking the unique physical attribute of the physical media to the image printed on the physical media.*” Emphasis added. Finally, new independent claim 35 recites “means for encoding the document key with an element of an image printed on the physical media to produce an encoded document key, *the encoded document key linking the unique physical attribute of the physical media to the image printed on the physical media.*” Emphasis added.

The Pease reference cannot anticipate claims 1, 18, 25, 32 and 35 or their dependent claims at least because Pease completely fails to disclose the recited limitations. In the Office Action at page 10, the Examiner acknowledges that Pease merely teaches an imager that generates opacity values being sensed by a transmissivity device. Moreover, Pease contains no teaching, suggestion or illustration regarding the facilitation of document authentication using a code that embodies information about the physical characteristics of the document itself, as well as the image disposed on the document.

As to the rejections under Section 103, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (P.T.O. Bd. App. 1979). Obviousness cannot be established by combining the teachings of

the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (Bd. Pat. App. & Inter. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Moreover, the Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

The Applicant respectfully traverses the rejection of claims 2, 4, 6-8 and 10-15 under Section 103 because the references cited by the Examiner considered alone or in combination do not include each and every element of the claims. As set forth above, no reference cited by the Examiner teaches, suggests or illustrates the facilitation of document authentication using a code that embodies information about the physical characteristics of the document itself, as well as the image disposed on the document. Accordingly, because no combination cited by

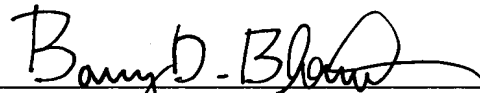
the Examiner includes all of the elements of the Applicant's claims, the Applicant respectfully asserts that a *prima facie* case of obviousness has not been established.

Conclusion

In view of the remarks and amendments set forth above, the Applicant respectfully requests an indication of allowability of all claims (1-15 and 18-37). If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Date: 28 Sep 04

Respectfully submitted,



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